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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,965	12/07/2001	Mitsuaki Oshima	MTS-520US4	8891

7590 06/17/2009
Allan Ratner
Ratner & Prestia
P.O. Box 980
Valley Forge, PA 19482

EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Rule 312 Communication	Application No.	Applicant(s)
	10/017,965	OSHIMA ET AL.
	Examiner	Art Unit
	PAUL CALLAHAN	2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ The amendment filed on 18 February 2009 under 37 CFR 1.312 has been considered, and has been:

a) ☐ entered.

b) ☐ entered as directed to matters of form not affecting the scope of the invention.

c) ☐ disapproved because the amendment was filed after the payment of the issue fee.

Any amendment filed after the date the issue fee is paid must be accompanied by a petition under 37 CFR 1.313(c)(1) and the required fee to withdraw the application from issue.

d) ☒ disapproved. See explanation below.

e) ☐ entered in part. See explanation below.

See Continuation Sheet

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437

Continuation of 1 (e) Entered in part. See explanation:

1.) The Applicant has requested a Supplemental Notice of Allowability be issued in order to correct a perceived error in the claim numbering of the allowed claims. The Applicant asserts that the allowed claims should be renumbered as claims 32 and 33 instead of as claims 31 and 32 as shown in the Notice of Allowability mailed 1-14-2009.

The Applicant bases his version of the claim numbering on the belief that the instant application was originally filed with a preliminary amendment that cancelled claims 1-27 of the surrendered Patent, and added new claims 28-31.

The Examiner acknowledges that the "Applicant's Remarks" section that accompanied the original preliminary amendment does state "claims 28-31 are newly added." However, the Examiner again points out that the preliminary amendment only contained new claims 28-30 and that the page containing new claim 31 was either not filed with the preliminary amendment or became separated from it. The Applicant's own filing on 1-14-2009 of a copy of the original preliminary amendment shows that only claims 28-30 were included. No claim 31 is found.

The Examiner has repeatedly pointed out that no claim 31 was filed with the original preliminary amendment, and that the Applicant's subsequent amendments which attempted to enter new claims starting with claim number 32 were incorrect.

The Examiner has addressed this issue previously, for example: in paragraph 2 of the non-final Office Action mailed 10-2-2003:

""2. In the response filed 04/01/2003 the Applicant's Representative expressed concern over potential error in the numbering of the claims as they were treated in the previous Office Action in the case. It is the Applicant's Representative's expressed belief that there are two (2) claims pending in this application and that they are numbered claims 32 and 33. The Examiner has carefully reviewed the file history and finds the following history of the claims:

- * Claims 1-27: Original claims found in the Patent 5,761,301.
- * Claims 28-30: Added with the filing of this reissue divisional application 10/017,965 on 12/07/2001
- * Claims 1-27: Cancelled by the preliminary amendment filed 12/07/2001. This preliminary amendment mistakenly states, "New claims 28-31 have been newly added and attached to this divisional application." The Examiner finds that in fact that only claims 28-30 were added.
- * Claims 28-30: Cancelled by the supplemental preliminary amendment filed 07/21/2002. The amendment mistakenly states: "Please cancel claims 28-31" The Examiner finds only claims 28-30 were pending at that time. New claims 31 and 32 were added.
- * Claims 31 and 32 were pending as of the filing date of the latest communication from the Applicant's Representative, i.e., the response to the non-final Office Action mailed 12-03-2002.""

The Applicant's attempt to add claims 32 and 33 by amendment was improper according to 37 CFR 1.126 which states: " When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). As per PTO practice outlined in MPEP 608.01, the Examiner renumbered claims 32 and 33 as claims 31 and 32 since the highest numbered claim previously presented was claim 30.

The Applicant may wish to inspect the paper file of the instant application held at the PTO, or order a copy of it from the PTO, if questions remain about the claim count of the original preliminary amendment and subsequent amendments.

2.) The Applicant has requested a Supplemental Notice of Allowability be issued in order that the supplemental Declaration filed 10-31-2008 be considered. The Examiner considered the Declaration prior to the mailing of the Notice of Allowability on 1-14-2008 and the Declaration was found to be proper.

3.) The Applicant has asked that the IDS filed 4-24-2008 be considered. The IDS was considered prior to the mailing of the Notice of Allowability on 1-14-2009 and was not found to affect the previously indicated allowability of the claims. A copy of the initialed, signed, and dated Form 1449 will be sent under separate cover.